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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/868,216	06/03/97	GIORDANO III J	INFG0002

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EXAMINER	
NGUYEN, K	
ART UNIT	PAPER NUMBER
2731	

DATE MAILED: 03/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/868,216

Applicant(s)
Joseph Giordano III

Examiner
Kim Nguyen

Group Art Unit
2731



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being arranged in wrong order of steps. The step of “transparently disconnecting from said session ... calling said telephone number” in claim 2 lines 3-4 must follow the step of “converting said telephone number to an iconic representation” in claim 1 line 6.

The step in claim 2 lines 3-4 can not be included in the recognizing step of claim 1.

Because at the recognizing step, the telephone icon have not been formed yet.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoff (US. Patent No. 5,822,539).
 - a. As per claim 1, 4, 7 and 10-11, Van Hoff teaches a method for identifying a pattern within an electronic document during a communication session. The method comprises the steps of:

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parsing the electronic document; recognizing a pattern and converting the pattern to an iconic representation (col. 2, lines 35-38 and col. 5, lines 37-50).

Van Hoff does not explicitly teach recognizing a telephone number and converting the telephone number to an iconic representation. However, Van Hoff teaches recognizing a pattern which can be characters or numbers (col. 5, lines 37-50). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to recognize the telephone number as the pattern taught by Van Hoff because the telephone number is a pattern of a set of numbers.

b. As per claim 12, Van Hoff does not explicitly teach parsing algorithm method. However, Van Hoff teaches recognizing a pattern by parsing an electronic document. It would have been obvious to a person of ordinary skill in the art at the time the invention was made that Van Hoff must include parsing algorithm which performs similar function as claimed.

4. Claims 2-3, 5-6, 8-9 and 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoff (US. Patent No. 5,822,539) in view of Shachar et al (US. Patent No. 5,764,736) (hereinafter Shachar).

a. As per claim 2 and 13, Shachar teaches transparently disconnecting from the session upon selection of the iconified telephone number and calling the telephone number (col. 6, lines 1-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the method of iconifying telephone number taught by Van Hoff with dialing

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the telephone number taught by Shachar. The motivation for doing so would have been to allow a user to establish a telephonic session by clicking on the icon representing the telephone number.

b. As per claim 3, Shachar teaches reconnecting a suspended session when the telephone session is terminated (col. 6, lines 11-14).

c. As per claim 5-6, Shachar teaches an Internet-capable telephone device (col. 6, lines 24-27). Further, the claimed transmitting and displaying the electronic document to a complementary device would have been well known to a person of ordinary skill in the art at the time the invention was made.

d. As per claim 8-9 and 14, the claimed limitations would have been well known to a person of ordinary skill in the art at the time the invention was made.

e. As per claim 15, refer to the discussion in claims 1-3 above.

f. As per claim 16-20, refer to the discussion in claims 12, 9, 10, 11 and 14 above.

g. As per claim 21-22, refer to the discussion in claim 15 above. The claimed system is the extent of the claimed method.

h. As per claim 23, refer to the discussion in claims 1-3 above. The claimed access appliance is the extent of the claimed method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:00PM ET.

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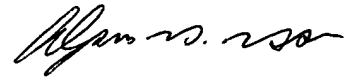
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378. The fax phone number for this Group is (703) 308-6743.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

KTN

3/12/99



**ALPUS H. HSU
PRIMARY EXAMINER**